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CENTRAL FAX CENTER****AUG 21 2006****REMARKS**

Claims 1, 4, 6 and 10 are amended. Claims 1 and 10 have been amended for the sake of clarity; their scope has not been affected. Reconsideration of claims 1, 3-6, 10 and 11 is respectfully requested.

In the office action dated July 7, 2006, the Examiner rejected claims 5 and 6 under U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded by the Applicant as the invention. The Examiner also rejected claims 1, 3-6, 10 and 11 under 35 U.S.C. § 103(a) as being obvious in view of Carmichael (U.S. patent number 4,003,279) in conjunction with Ward (U.S. patent number 3,874,122).

Claims 4 and 6 have been amended to remedy the § 112 rejection. Claim 4 has been amended by the addition of "hydraulic" to the description of the "power means", thereby providing a proper antecedent basis for claim 5's "said hydraulic power means". Likewise, claim 6 has been amended by replacing "drive shaft" with "pinion". Because claim 3, upon which claim 6 depends, introduces a pinion connected to movable tooling, claim 6 no longer lacks an antecedent basis.

Additionally, the Applicant has carefully considered the Examiner's § 103(a) rejection, but respectfully traverses the rejection because Carmichael does not disclose a means for alternately driving the movable tooling in opposite directions, because one skilled in the art would not look to Ward to create a supported shear, and because there is no teaching, motivation, or suggestion to combine Carmichael and Ward.

The Examiner states that Carmichael discloses a supported shear of the type which shears tube stock by lateral displacement of adjacent lengths of stock along a shear plane extending orthogonally through the stock, a mandrel to be placed within the stock, stationary tooling for receiving and holding the stock, movable tooling for receiving and holding the stock, and means for alternately driving the movable tooling in opposite directions through an orbital path relative to the stationary tooling. However, Carmichael does not disclose means for alternately driving the movable tooling in opposite directions through an orbital path relative to the station tooling. Carmichael at column 4, lines 24-31, cited by the Examiner for disclosure of this feature, merely reads, "As a further alternative the orbital shearing movement could be completed in only 180°, giving a faster cycling time but additional complexity as the die then needs to move in opposite directions to get back to the starting position from the orbital shearing position for alternate cycles." Carmichael does not disclose any means for actually alternately driving the movable

tooling in opposite directions through an orbital path relative to the stationary tooling, as no structure for achieving this objective is disclosed. Instead, this passage is evidence of the need for structure capable of alternately driving the movable tooling in opposite directions and advises against using this approach. Therefore, Carmichael does not disclose alternately driving the movable tooling in opposite directions.

Even if Carmichael were to disclose alternately driving the movable tooling in opposite directions through an orbital path relative to the stationary tooling, the present invention still would not be obvious. The Examiner clearly appreciates that Carmichael does not disclose that the means include first and second hydraulic cylinders; a pinion between two simultaneously, oppositely moving racks; means for varying the power level of the means to drive the racks; and that the total linear displacement of the first rack is at least approximately equal to one revolution of the pinion. To make up for Carmichael's shortcomings, the Examiner points to Ward. Ward, however, cannot remedy Carmichael's shortcomings in order to make the present invention obvious.

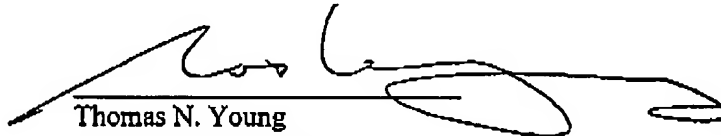
The first problem with Ward is that it is non-analogous art; i.e., one skilled in the art of tube shearing would not even look to Ward. Ward discloses a grinding machine, while the present invention is for a supported shear. The problem solved by Ward is to lathe opposing faces of an object without having to re-orient the object after lathing one side, whereas the problem solved by the present invention is to efficiently shear linear stock. Certainly, one of ordinary skill would never consider using a lathe to cut linear stock in desired lengths, and would therefore not consider Ward. Likewise, Ward does not fall within the preamble language of the claims at issue here. Therefore, Ward is not analogous art.

Assuming, arguendo, that Carmichael discloses alternately driving the movable tooling in opposite directions through an orbital path relative to the stationary tooling and Ward is analogous art to the present invention, a teaching, suggestion, or motivation to combine features of Carmichael and Ward is missing. The Examiner claims that it would have been obvious to one of ordinary skill in the art to have provided Carmichael with the linear drive of Ward. However, the Examiner provides no basis for this conclusion. While Carmichael mentions alternately driving the movable tooling in opposite directions, there is no suggestion to use hydraulic cylinders, a pinion, and a first and second rack to achieve the objective. Nor is there a suggestion to vary the power level or make the total linear displacement of the first rack equal to one

revolution of the pinion. Thus, Carmichael does not suggest the present invention, but only suggests the need for the present invention.

Without a teaching, suggestion, or motivation, the Examiner has engaged in impermissible hindsight reconstruction; i.e., selecting elements from Ward in an attempt to transform Carmichael into the present invention. This can only be done if the Applicant's disclosure is used as a guide. Thus, the Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness, and respectfully requests that this rejection be withdrawn.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas N. Young', written over a horizontal line.

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Our Reference: TMA-105-B

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John J. Borzym
Serial Number: 10/762,430
Filing Date: January 22, 2004
Examiner/Art Group Unit: Maurina T. Rachuba/3723
Title: SUPPORTED SHEAR WITH REVERSIBLE DRIVE
AND METHOD OF OPERATING SAME

CERTIFICATION OF FACSIMILE TRANSMISSION

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted with this document is an Amendment in the above-identified application.

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Number 25-0115.

I hereby certify that this correspondence was transmitted, via Facsimile, to Examiner Maurina T.
Rachuba at Art Unit 3723 at 571-273-8300 on August 21, 2006.

Respectfully submitted,

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